

REMARKS/ARGUMENTS

The Office Action notes that claims 1-33 (claims 30-33 were misnumbered as 31-34) are pending in the application. By this amendment, claim 21 has been amended and claims 31-34 have been renumbered as claims 30-33. The amendment to claim 21 is fully supported by the Specification and does not add any new matter to the application. Therefore, claims 1-33 are still pending in the application.

In the Office Action, the Examiner: (1) objected to claims 31-34 as being misnumbered; (2) rejected claims 18, 19, and 21 under 35 USC §103(a); (3) objected to claims 20 and 22 as being dependent on a rejected base claim; and (4) allowed claims 1-17 and 23-33. The Office Action notes that claims 20 and 22 would be allowable if rewritten in independent form including all of the limitations of the base claims and any intervening claims. Applicant responds to the Examiner's objections and rejections below.

Objection to Claims 31-34

The Examiner objected to claims 31-34 because the claims were misnumbered. Applicant has amended claims 31-34 and renumbered them 30-33 accordingly.

Claim Rejections - 35 USC §103

The Examiner rejected claims 18, 19, and 21 under 35 USC §103(a) as being unpatentable over Strand '979 in view of Johnson et al. '940. Applicant respectfully submits that claims 18, 19, and 21 (as amended) are patentable over Strand in view of Johnson.

As to claims 18 and 21 (as amended), neither Strand nor Johnson disclose a "means for directing pressurized air into the two chambers" as recited in claims 18 and 21 (as amended). In Strand, the two chambers are chamber b and chamber b' and there is no means for directing

water into the two chambers. The device disclosed in Strand is a water-wheel that can rotate opposite directions depending on which chamber the water is fed. Therefore, directing the water into the two chambers (b and b') would prevent the water-wheel disclosed in Strand from working as each chamber would be attempting to rotate the water-wheel in opposite directions. In fact, Strand specifically states that the "construction causes the water, when expelled through the pipes B [which extend from chamber b], to rotate the wheel in one direction, while, when expelled through the pipes B' [which extend from chamber b'], it revolves the wheel in the opposite direction. This necessitates the construction of a mechanism for regulating the flow of water into only one series of pipes [and therefore chamber] at a time." In addition, Johnson does not even disclose a turbine rotor having two chambers at all, it discloses a vane motor. Therefore, even if such a combination as Strand and Johnson were made, the purported combination still would not disclose all of the elements recited in claims 18 and 21.

Claim 19 is dependent on claim 18, therefore, for the reasons stated above claim 19 is also patentable over Strand in view of Johnson.

In addition, Applicant submits that it would not have been obvious to one having ordinary skill in the art at the time the invention was made to combine the Strand and Johnson references.

First, the Strand and Johnson references are completely unrelated. The water-wheel disclosed in Strand is a water powered turbine rotor and the toy vehicle in Johnson incorporates a vane rotor. Turbine and vane rotors are completely different in operation and it would not have been obvious to combine technology from a vane rotor into a turbine rotor. In addition, Strand is specifically directed to vertical water-wheels while Johnson is specifically directed to a launching system for a toy vehicle. These fields are completely unrelated and it would not have been obvious to combine technology from one into the other.

Second, there is no, and could be no, suggestion or motivation to modify the device disclosed in Strand to incorporate air as the powering fluid, as disclosed in Johnson, because such a combination would render the Strand device unsatisfactory for its intended purpose, a water-wheel.¹ Strand specifically states that the invention disclosed is directed to water-wheels, or vertical water-wheels², and using air as the powering fluid would render the Strand device unsatisfactory as a water-wheel.

Third, there is no suggestion or motivation in Strand to modify the device to be used with air.³ To the contrary, as stated above, Strand specifically states that it is directed to water-wheels and even states that the weight of the water in the pipes is part of what provides rotation to the wheel.

Fourth, Applicant respectfully traverses the Examiner's assertion that, "[i]t would have been obvious...to have used air as the powering fluid in the turbine of Strand...as a matter of preference since any fluid that is compressible and flowable is generally suitable." Applicant asserts that it would not have been obvious to use a gas, such as air, in a device such as Strand that is specifically designed and disclosed to be a water-wheel.

Therefore, Applicant respectfully submits that claims 18, 19, and 21 (as amended) are allowable over Strand in view of Johnson.

¹ See MPEP2143.01 ("If proposed modification would render the prior art invention being modified unsatisfactory for its intended purpose, then there is no suggestion or motivation to make the proposed modification. *In re Gordon*, 733 F.2d 900, 221 USPQ 1125 (Fed. Cir. 1984)")

² See US Patent 188,979 (e.g. "...I, August B. Strand...have invented certain new and useful Improvements in Water-Wheels..."; "This invention relates to that class of vertical water-wheels in which the water is fed into the center or core of the wheel and discharged at its periphery..."; "A is a circular plate or disk, which forms the body of my improved water-wheel.")

³ See MPEP 2143.01 ("The mere fact that references can be combined or modified does not render the resultant combination obvious unless the prior art also suggests the desirability of the combination. *In re Mills*, 916 F.2d 680, 16 USPQ2d 1430 (Fed. Cir. 1990) (...Although a prior art device "may be capable of being modified to run the way the apparatus is claimed, there must be a suggestion or motivation in the reference to do so."...)"

Objection to Claims 20 and 22

The Examiner objected to claims 20 and 22 as being dependent upon rejected base claims. Claim 20 is dependent on claim 18 and claim 22 is dependent on claim 21. As discussed above, Applicant respectfully submits that claims 18 and 21 (as amended) are allowable over Strand in view of Johnson and therefore respectfully requests that this objection be withdrawn.

Conclusion

In view of the aforesaid, Applicant respectfully submits that claims 1-33 are in condition for allowance and a Notice of Allowance for these claims is respectfully requested.

Respectfully submitted,

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